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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,850	01/21/2004	Daniel R. Lynn	F-5581 CIP DIV DIV	3059
7590	01/05/2006			
BAXTER HEALTHCARE CORPORATION Bradford R.L. Price Fenwal Division RLP-30 Route 120 and Wilson Road Round Lake, IL 60073			EXAMINER KIM, SUN U	
			ART UNIT 1723	PAPER NUMBER
DATE MAILED: 01/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

25

**Office Action Summary**

Application No.

10/761,850

Applicant(s)

LYNN ET AL.

Examiner

John Kim

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/21/04</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1723

1. The information disclosure statement filed 1/21/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Excerpts from Opposition involving EP 684,867 (European Counterpart of Lynn et al. US 5,591,337 including (D1)...(D7) US 4,157,967 and European Patent No. 0155005 are missing.

2. The disclosure is objected to because of the following informalities: On lines 5-6 of page 1 of the specification, application no. 10/159,442 needs to be updated as US Pat. No. 6,745,902.

Appropriate correction is required.

3. Claims 1 and 4 are objected to because of the following informalities: "at" on line 2 of claim 1 needs to be corrected to "an". "the inlet filter layer" on line 2 of claim 4 needs to be corrected to "the inlet layer". Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 5,591,337 (hereinafter referred to as Lynn '337). Lynn '337 teaches a blood filter assembly comprising filter pad assembly comprising a prefilter inlet layer (28), an outlet layer (32) and an intermediate fiber filter media (30), a filter housing comprising a first flexible sheet (44)

Art Unit: 1723

overlying the inlet layer (28) and a second flexible sheet (46) overlying the outlet layer (32), a peripheral seal (48, 34) formed by radio frequency heating and pressure to join the first and second flexible sheets (44, 46), the peripheral seal (48, 34) inherently comprising a commingled melted matrix comprising first and second flexible sheets (44, 46) and fiber filter media (28, 30, 32), an inlet port (36) in the first flexible sheet (44) spaced from the peripheral seal (48, 34) and an outlet port (38) in the second flexible sheet (46) spaced from the peripheral seal (48, 34) (see figures 2-7; col. 3, line 55 – col. 10, line 27)(claim 1). Regarding claim 2, Lynn ‘337 shows that the rims of first and second flexible sheets (44, 46) are sealed together outwardly of the peripheral seal (34) and outwardly of the peripheries of layers (28, 30, 32) (see figure 6A; claim 2). Regarding claim 3, Lynn ‘337 teaches that inlet and outlet ports (36, 38) include an axis that is generally parallel to a plane of the inlet and outlet layer (28, 32) (see figures 2-6; claims 4-5). Regarding claims 4-5, Lynn ‘337 teaches that inlet filter layer (28) is a prefilter comprising of filter filter media (see col. 5, lines 61-63; col. 6, lines 25-31). Regarding claim 6, Lynn ‘337 teaches that the intermediate layer (30) is a leukocyte removal filter (see col. 5, lines 64-65). Regarding claim 7, Lynn ‘337 teaches the method including the step of conveying blood from a source through the filter assembly (see col. 4, lines 16-23). Regarding claim 8, Lynn ‘337 teaches a container (12), a tubing in communication with the container and a blood filter 916) carried in line in the tubing (see figure 1; col. 3, line 54 – col. 4, line 15).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is

Art Unit: 1723

appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 4-9 of U.S. Patent No. 5,591,337 (Lynn '337).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the second heat and pressure sealed region of Lynn '337 that joins the rims of the housing elements to the first heat and pressure sealed region of filter layers inherently forms a peripheral seal comprising a commingled melted matrix comprising material of the first and second housing elements and fiber filter media of the filter pad assembly.

Art Unit: 1723

8. Claims 1, 4-6 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4 and 6 of U.S. Patent No. 6,422,397 or US Patent No. 6,367,634 in view of U.S. Patent No. 5,591,337 (Lynn '337). Claims 1-2, 4 and 6 of U.S. Patent No. 6,422,397 or US Patent No. 6,367,634 teach the claimed blood filter device of claims 1, 4-6 and 8 of the instant application except that the filter medium is a filter pad assembly comprising fiber filter media. Lynn '337 teaches filter pad assembly comprising fiber filter media that are heat and pressure sealable to form a seal (34) wherein the essential symmetry of the filter pad assembly (20) maximizes the surface area available for leukocyte removal as the peripheral seal (34) occupies only a relatively small area of the overall pad assembly (see col. 5, line 58 – col. 8, line 54). It would have been obvious to substitute filter pad assembly comprising fiber filter media that are heat and pressure sealable for filter medium of meltable filter layer of U.S. Patent No. 6,422,397 or US Patent No. 6,367,634.

9. Claims 1, 4-6 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 4 of U.S. Patent No. 6,745,902 in view of U.S. Patent No. 5,591,337 (Lynn '337). Claims 1-2 and 4 of U.S. Patent No. 6,745,902 teach the claimed blood filter device of claims 1, 4-6 and 8 of the instant application except that the filter medium is a filter pad assembly comprising fiber filter media. Lynn '337 teaches filter pad assembly comprising fiber filter media that are heat and pressure sealable to form a seal (34) wherein the essential symmetry of the filter pad assembly (20) maximizes the surface area available for leukocyte removal as the peripheral seal (34) occupies only a relatively small area of the overall pad assembly (see col. 5, line 58 – col. 8, line 54). It would have been obvious to


Art Unit: 1723

substitute filter pad assembly comprising fiber filter media that are heat and pressure sealable for filter medium of meltable filter layer of U.S. Patent No. 6,745,902.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-1142. The examiner can normally be reached on weekdays from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**John Kim**  
**Primary Examiner**  
**Art Unit 1723**

J. Kim  
January 3, 2006